

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS & INTERFERENCES

Applicant: Donald E. Wallar II

Serial No.: 09/471,429

For: MESSAGE COMPOSITION FOR COMPUTER, MEMORY MEDIA
AND METHOD

Filed: December 23, 1999

Examiner: Sanjiv Shah

Art Unit: 2627

Confirmation No.: 7384

Customer No.: 64612

Attorney Docket No. ST9-99-070

Mail Stop Appeal Brief – Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Dear Sir:

In response to the Examiner's Answer dated August 22, 2007, Appellants file this Reply Brief under 35 U.S.C. §134 and 37 C.F.R. §41.41.

Status of the Claims begins on page 2 of this paper.

Grounds of Rejection to be Reviewed begin on page 3 of this paper.

Appellants' Argument begins on page 4 of this paper.

I. Status of the Claims

Claims 1 – 7 and 10 – 29 are subject to appeal. Claims 8 and 9 have been cancelled.

The Final Office Action, mailed October 13, 2006, rejected Claims 1, 10, 15, and 20 – 29 as obvious under 35 U.S.C. §103(a) over U.S. Patent No. 5,911,776 to Guck (hereinafter, “Guck”), in view of U.S. Patent No. 6,629,130 to Mertama (hereinafter, “Mertama”), and Claims 2 – 7, 11 – 14, and 16 – 19 as obvious over Guck, in view of Mertama, and further in view of U.S. Patent No. 6,230,173 to Ferrel, et al. (hereinafter, “Ferrel”).

Appellants filed a Response to Final Office Action on January 4, 2007. No claims were amended. An Advisory Action was mailed on February 9, 2007. On May 3, 2007, a Notice of Panel Decision from Pre-Appeal Brief Review was mailed that maintained the pending rejections, and referred the matter to the Board of Patent Appeals and Interferences.

On July 3, 2007, Appellants filed an Appeal Brief, appealing from the Final Office Action mailed October 13, 2007. An Examiner’s Answer was mailed on August 22, 2007.

The arguments provided in this Reply Brief specifically address the issue raised in the “Response to Argument” in the Examiner’s Answer.

II. Grounds of Rejection to be Reviewed

The issues to be reviewed on appeal are: (1) whether claims 1, 10, 15, and 20 – 29 are obvious under 35 U.S.C. §103(a) over U.S. Patent No. 5,911,776 to Guck in view of U.S. Patent No. 6,629,130 to Mertama, et al.; and (2) whether claims 2 – 7, 11 – 14, and 16 – 19 are obvious over Guck in view of Mertama, et al., and U.S. Patent No. 6,230,173 to Ferrel, et al.

On page 11 of the Examiner's Answer, mailed on August 22, 2007, the section entitled "(10) Response to Argument" raised an issue to which Appellants provide a specific reply in this Reply Brief.

The Examiner's Answer also reproduces, unchanged, all of the pending rejections from the Final Action of October 13, 2006. Since the rejections are unchanged from the Final Action, Appellants rely on the arguments presented in the Appeal Brief, and those arguments are hereby incorporated herein.

III. Argument

On page 11 of the Examiner's Answer, the section entitled "Response to Argument" (subsections 10-A and 10-B) states a definition of "unformatted," found in www.dictionary.com, as "Not being in or having a proper format." Appellants respectfully submit that the Examiner's Answer is in error where it concludes that it would have been obvious that the primary reference, Guck, teaches an "unformatted" message, in view of this definition.

Briefly, Guck discloses a network enabling an author to create and store an original formatted document as a "source" file that is a designated object in a database. Guck describes a second type of file, designated a "shadow" file, that has no content of its own but is dedicated to a particular output format. This shadow file "points" to the "source" file and also points to a "converter." Guck's "converter" transforms the formatted content of the source file into another file having the desired format of the receiving application. (Guck at col. 4, lines 41 – 54).

In the context of Guck's disclosure, Appellants respectfully submit that a **formatted** message or source file that is subsequently converted into a **different format** (in order to be received by the receiving appliance) is *still* a **formatted message** or source file, and would be understood by a person of skill in the art as distinct from an "unformatted" message. Thus, an unintended meaning is being read into the definition of "unformatted," causing an erroneous conclusion in the Examiner's Answer.

This is particularly evident when considering Guck's disclosure, in its original context, about originating a text or message in a particular (personal) format:

"It would be most desirable to provide a network where any client, **no matter what format his document consists of**, or what his personal computer protocol utilizes, could create, originate, or author a document and **enable this document's content to be transmitted to and received by** personal computer clients or appliances **using different types of protocol** so as to be received by appliance such as FAX machines, telephones and E-Mail users. Heretofore, this has not been done with any great efficiency whereby an originator or author **could originate a text or message in his own personal format** and using his personal appliance protocol, and send it to multiple receiver users...after it has been **automatically processed and handled by a server** which **distributes his origination in any and all formats** necessary to be received..." [emphasis added] (Guck, col. 2, lines 1 – 17).

Guck provides this further description of what he means:

"As an example, let it be assumed that the User-author **generates a document** with content using the common universal **format** designated as RTF. This designates 'Rich Text Format' which is a Microsoft standard for encoding **formatted** text and graphics. Now if the user wishes to send this document onto a FAX machine, it would be necessary to **convert the RTF format into another format such as TIFF**...In general, there are a large number of possible **formats** that the user may want to utilize." [emphasis added] (col. 6, line 65 – 67 and col. 7, lines 1 – 4, 12 – 13).

By contrast, claim 1 of the present application provides in relevant part, a "...message composition area for entry of an **unformatted message**...in response to the entry of an **unformatted message...converting said unformatted message to form a formatted message...with format tags**...wherein format tags are assigned to said formatted message and said formatted message is structured for display based on selection field data from said at least one associated selection field." [emphasis added].

Thus, Guck only discloses a system where an author generates an originating text or message in some **particular format**, from which the text or message can be converted into a different format (or protocol) in order to be compatible with a receiving appliance. Accordingly, a reasonable interpretation of the www.dictionary.com definition of “unformatted” by a person of ordinary skill in the art would *not* have caused that person to conclude that it was obvious that the originating text or message in Guck was an “unformatted” text or message. Therefore, Examiner’s Answer errs by concluding that claim 1 (or any of the pending claims) is rendered obvious over Guck because of the www.dictionary.com definition of “unformatted.”

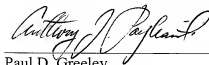
The Examiner’s Answer does not provide additional arguments for the Mertama and Ferrel references. Accordingly, Appellants continue to rely on the description and arguments presented in the Appeal Brief addressing Mertama and Ferrel, and incorporate those arguments herein as to each of the rejected claims.

Appellants submit that claims 2 – 7 and 10 – 29, for the same reasons as provided for claim 1, are not rendered obvious by Guck, taken alone or in combination with Mertama and/or Ferrel, in view of the www.dictionary.com definition of “unformatted” that was provided in the Examiner’s Answer.

Appellants thank the Board for its consideration of this Reply Brief to the Examiner's Answer. For purposes of this appeal, claims 1 – 7 and 10 – 29 should be grouped together. In view of the arguments presented in the Appeal Brief, as well as in this Reply Brief, Appellants respectfully request that the Board reverse the final rejections of claims 1 – 7 and 10 – 29, thereby enabling all of the pending claims to be allowed.

10/22/07
Date

Respectfully submitted,



Paul D. Greeley
Registration No. 31,019
Anthony J. Paviglianiti
Registration No. 45,000
Attorneys for Appellants
Ohlandt, Greeley, Ruggiero & Perle, LLP
One Landmark Square, 10th Floor
Stamford, CT 06901-2682
Tel: (203) 327-4500
Fax: (203) 327-6401